

Remarks:

This Amendment is in response to the Office action dated July 14, 2005 in regard to pending claims 1-12.

Examiner requested an update to the priority statement. Applicant represents that the Preliminary Amendment dated December 2, 2004, contains the required update.

Examiner objected to the specification at page 31, lines 4-5 for blank spaces. Applicant represents that the blank spaces were an artifact of MSWord: margins of the document were arranged and printed on a "justification" setting of the software: no new material was omitted or is to be added. Applicant respectfully requests that the blank spaces are deemed part of the word-processed format of the subject line on page 31, and that the objection to the specification be withdrawn.

Examiner rejected claims 1 and 2 as being indefinite as being unclear, in the last line of claim 1, to what is being referred to as "H". Applicant amends to claim to correct the typographical error identified in Examiner's rejection, and respectfully requests that this rejection be withdrawn in view of Applicant's correction.

Examiner rejected claims 1-12 under 35 U.S.C. 112, second paragraph, as being indefinite for reciting "peptide YY functional analogs". Applicant respectfully traverses this rejection. Analogs are described in the specification at page 30:

PYY functional analogs include PYY (22-36), BIM-43004 (Liu, CD. et al., J. Surg. Res. 59(1):80-84 [1995]), BIM-43073D, BIM-43004C (Litvak, D.A. et al., Dig. Dis. Sci. 44(3):643-48 [1999]). Other examples of peptide analogs are also known in the art (e.g., Balasubramaniam, U.S. Patent No. 5,604,203).

Further, one of ordinary skill would recognize analogs to include a variety of conjugates including Peptide YY modified by pegylation or acylation. To expedite prosecution, however, Applicant amends the claims, without prejudice or disclaimer, to cancel the rejected subject matter. Applicant amends the claims with the *proviso* that he will file a divisional application to continue to prosecute the canceled subject matter.

Upon entry of this Amendment, claims 1-12 are pending in the instant application. These claims as amended are limited to "peptide YY". One of ordinary skill at the time of the filing of the instant application would understand peptide YY to include the intact full length (36 amino acids) peptide as well as biologically active, naturally occurring, inherent

metabolic products, for example, peptide YY(3-36). These peptide YY metabolic products are disclosed in references filed in applicant's prior IDS submissions of record. Consideration of the foregoing in relation to the instant application is respectfully requested. Applicant respectfully requests that the rejection of pending claims for reciting "peptide YY analog" be withdrawn in view of the amendments.

Examiner provisionally rejected claims 3 and 6 under the doctrine of obviousness-type double patenting as being unpatentable over claim 19 of co pending Application No. 10/853,824, and also rejected claims 1-12 on this basis over claims 1-10 of U.S. Patent No. 6,558,708. The inventive entity of the instant application is the same as co pending Application No. 10/853,824 and U.S. Patent No. 6,558,708. Further, the assignee of the entire interest in the two applications and the patent cited by Examiner are the same. To obviate the rejections, applicant herewith submits a TERMINAL DISCLAIMER TO OBVIATE A PROVISIONAL DOUBLE PATENTING REJECTION OVER A PENDING SECOND APPLICATION (PTO Form SB25) and a TERMINAL DISCLAIMER TO OBVIATE A DOUBLE PATENTING REJECTION OVER A PRIOR PATENT (PTO Form SB26). Applicant hereby disclaims the portion of the term of the patent that extends beyond the term of applicant's copending patent application and issued patent. Applicant provides that any patent granted on the instant application shall be enforceable only for and during such period that said patent is commonly owned with applicant's co pending patent application and issued patent, which formed the basis for Examiner's rejections. Applicant respectfully requests that the rejection of claim 1-12 over applicant's co pending patent application and issued patent be withdrawn.

In view of the Amendment and Remarks, Applicant believes that all the claims pending in the instant application are in condition for allowance. Applicant's attorney requests a telephone conference to discuss the current Amendment.

October 14, 2005
Date

Respectfully submitted,



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